

REMARKS

Claims 1-11, 23-30, and 65-79 have been amended. New Claims 80-84 have been added. Applicant submits that all amendments are supported by the application-as-filed and that no new matter has been added. Claims 1-11, 23-30, and 65-84 are now in the application. Reconsideration of the application is respectfully requested in light of the foregoing amendments and the following remarks.

Amendments to the Specification

Minor amendments have been made in the specification at four locations. No new matter has been added.

The amendment at page 4 lines 20-24 merely explicitly identifies a pencil as a hand-held marker, which is inherent in the original recitation of a pencil.

The amendment at page 5 lines 3-4 merely recites that the word "machines" does not include hand-held markers, which it does not.

The amendment at page 14 line 35 to page 15 line 5 introduces the phrase marking machines in talking about the originally-recited printer and mechanical saw.

The amendment at page 16 lines 21-36 recites retail store or lumber yard as a location where products of the invention are sold to a consumer, and specifically states that the product is pre-marked when purchased by the consumer. These are concepts which are inherent in the teaching of the specification as originally filed.

Accordingly, no new matter is introduced into the application by the amendments to the specification.

The Finality of the Rejection is Improper

MPEP 706.07(a) states as follows

..."second or any subsequent actions on the merits shall be final except where the examiner introduces a new ground of rejection (as done here) that is neither necessitated

by applicant's amendment of the claims (only Claim 76 was amended, and only for purposes of improving clarity, definiteness) nor based on information submitted in an information disclosure statement (none submitted).

Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement...of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art. "

Applicant notes that the examiner has stated that the Office Action dated 2/14/2006 is a "Final" Action. Applicant respectfully points out that the only claim amendment in the previous response was amendment of Claim 76 responding to rejections under 35 USC 112 second paragraph. Applicant made no amendments on the merits. Rather, Applicant overcame the then-applied reference by submitting a Declaration under 37 C.F.R. 1.131. Applicant submits that a Declaration under 37 C.F.R. 1.131 finds no support in the MPEP as basis for designating the subsequent Office Action as "Final". Thus, the examiner's assertion of the new reference(s) was not necessitated by any action taken by Applicant.

To the contrary, the MPEP makes it clear that the Office Action cannot be made "Final" where the examiner asserts a new ground of rejection and the Applicant has not amended claims to necessitate the new grounds of rejection and the new reference is not taken from a newly-submitted IDS.

This is exactly the situation at hand, whereby the Finality of the 2/14/2006 Office Action is improper and must be withdrawn.

Applicant formally traverses the Finality of the Office Action dated 2/14/2006. Applicant respectfully requests that the Finality of the Office Action be withdrawn, and that examination proceed on that basis.

Claim Objections

Claim 8 stands objected to in that the examiner believes that Claim 8 is intended to depend from Claim 2, not Claim 24. The examiner is correct, and Claim 8 has been so amended. Withdrawal of the objection is respectfully requested.

Claim 76 is objected to because the citation "*the magnitude of the second distance is greater than the magnitude of the first distance*" assertedly does not have antecedent basis. Applicant respectfully traverses. The only wordings in the above-recited language which does not have specific antecedent basis are the two phrases the magnitude of.

The language at issue is discussing "distances", which does have antecedent basis. Applicant respectfully points out that every distance inherently has a magnitude. Accordingly, recitation of the magnitude inherently has basis in the previously-recited distance. Indeed, Applicant is of the distinct opinion that recitation of the phrase the magnitude adds clarity to the claim language.

Nevertheless, in order to remove this item as an issue, Applicant has deleted the two instances of the phrase the magnitude of. However, Applicant submits that the meaning of the claim is not changed. Applicant submits that both of the distances recited in Claim 76 inherently have magnitudes; and that the magnitudes of the distances are impliedly the crux of the relative distances recited in Claim 76 as now amended.

With the offending language deleted, Applicant submits that the objection has been overcome, and respectfully requests withdrawal of the objection.

Rejection of Claims Under 35 USC § 103

Claims 1-11, 27, 69, and 78-79 stand rejected as obvious in view of Currie (US 3,169,320). Applicant respectfully traverses the rejection.

Claim 1, prior to any amendment herein, claims a bundle of framing lumber, marked with stud locator markings, the bundle including at least one strap securing the lumber pieces together as said bundle.

Addressing the claimed bundle of lumber, it is critical to recognize the environment in which such bundle exists. Namely, as pointed out by the examiner, it is well known that pieces of lumber are bundled together for shipping. However, once the bundle of lumber arrives at the construction/job site, the bundle is opened (the strapping is removed), and individual pieces of lumber are selected and used as needed in the construction project.

There is no practice in the trade of putting lumber pieces back in a bundle, and strapping them, after they arrive at the job site. Rather, this is the time when the bundle is broken open, and individual pieces of lumber are used.

In that use, conventional practice says that the lumber pieces are individually marked, at the job site, by a worker who measures each piece of lumber to determine the marking locations, and who then makes such markings manually using e.g. a carpenter's pencil (See Jackson, column 1 lines 17-22). After a piece of lumber is marked, it is incorporated, along with other lumber pieces, in the framing structure of the building being built. There is no practice in the trade which teaches or suggests putting such marked piece of lumber back into a strapped bundle.

The Jackson reference, newly-cited by the examiner, recognizes, at column 1 lines 23-24, the problem solved in the instant invention. Jackson is a good illustration of the long-felt need in the industry, for accuracy in making the markings. However, prior proposed solutions, including Jackson and Currie, do not address the labor cost of making such markings with the desired level of precision.

The teaching of the applied reference to Currie is consistent with the above statement of conventional practice. The title of Currie is Framing Layout Tool. The teaching of Currie, for example set forth at column 2 lines 51-64 follows the above statement of steps. Namely, the reference teaches

1. Lay the tool on a piece of lumber.
2. Mark the piece of lumber.
3. Mark a second piece of lumber.
4. Lay out the various pieces of lumber, some marked, some unmarked, needed to make a respective portion of a wall assembly.

5. Assemble the pieces of lumber to make the portion of the wall assembly.

Clearly, the action steps recited in Currie are all steps which take place at the job site. It is well known that one does not assemble the framing, and then ship the framing to the job site. Similarly, one does not lay out all of the pieces of lumber, mark the sills, and then re-bundle the pieces.

The examiner states (page 3 lines 16-17 of the Office Action) "*To provide Jackson [sic Currie] lumber pieces in strapped bundles would be obvious for delivery to the job site as this is a conventional technique*". Such statement has no support in the reference. The examiner correctly recognizes that lumber is shipped to the job site in bundles. But all activity referred to in Currie or Jackson takes place at the job site, after the bundle has been opened, the strapping removed.

In applying the reference (whether Currie or Jackson) to the claim, it is critical to recognize the environment, and the timing, in which the tool of the reference is used. That environment is at the job site. The timing is after the strapping has been removed from the bundle of lumber. There is nothing in either reference, or any other reference, which says "after the lumber has been marked, put it in a bundle". The reason the references say nothing about a bundle of pre-marked lumber is because all of the references which the examiner has applied, including Currie and Jackson, speak to marking the lumber at the job site, which inherently means marking the lumber after the bundle has been opened.

By contrast, the invention speaks to marking the lumber before it arrives at the job site, such that the lumber arrives at the job site, already pre-marked. According to Applicant's specification, such pre-marking can be done e.g. *at the manufacturing facility where the lumber dimensions are established, at a retail facility, or at another [intermediate] manufacturing facility* (specification page 5 lines 28-31).

No prior art of record teaches or suggests such bundling of marked lumber. Rather, all prior art of record, which speaks to marking lumber, addresses such marking as being done at the job site, after the lumber has been removed from the bundle.

In light of the above, it is clear that Claim 1, before any amendment, is allowable over the Currie reference, the Jackson reference, and all other prior art references of record.

However, in the interest of moving the case toward allowance, Claim 1 has been amended to recite the claimed bundle of lumber as being pre-marked lumber, meaning that the lumber has been marked with stud indicator markings before the lumber arrives at the job site. The specification has been amended at page 16 to provide specific antecedent basis for the nomenclature pre-marked.

In order to further distinguish the claimed invention from the prior art, Claim 1 has also been amended to recite the stud locator markings reflecting application of the markings by at least one of a marking machine or a lumber-modifying process, not by a hand-held marker. This language finds support at page 14 line 35 to page 15 line 5, and elsewhere, in the application as originally filed.

Thus, Claim 1 has been amended to specifically require that the lumber product has been marked either by a marking machine or by a lumber-modifying process; and specifically excludes lumber product which has been marked by a hand-held marker.

No reference of record reflects marking which has been made by the recited marking machine or lumber-modifying process. Accordingly, Claim 1 is patentable on the basis of any one of the following:

- a. as it existed before the instant amendment,
- b. as pre-marked lumber as now recited in Claim 1, and
- c. as reflecting markings made by marking machine or lumber-modifying process.

Applicant respectfully requests withdrawal of the rejection of Claim 1, and all claims dependent therefrom, and allowance of all such claims.

Regarding dependent Claims 5, 27, 69, and 78-79, the examiner acknowledges that Currie fails to teach the recited consistency of variations being no more than 0.13 inch. The examiner asserts that it would have been an obvious matter of design choice to use the distance as specified in the claims.

Applicant submits that the specificity is a benefit derived from the fact that the marking is done in an industrial or commercial setting, not by a hand held marker, where the distances can be controlled more closely than where a worker makes the markings manually. Restated, the conventional practice of manually marking the stud spacings is

unable to consistently produce the precision recited in Claim 1, whereby the trade tolerated greater variations because no technology was known in the trade for cost-effectively achieving greater precision. Now that markings are made by a machine, or other industrial or commercial process, in the invention, the quality of the markings, including consistency of spacing can be and is improved, can be and is more closely controlled, cost-effectively.

Applicant submits that patentability is not negated by the fact that the trade/industry conventionally accepted lesser quality work because no better quality work was available until the invention was invented. To the contrary, Applicant submits that the examiner has not shown any reference which teaches the capability to make markings to the level of precision recited in the claims, whereby the claimed invention is patentable as an improvement in the ability to cost-effectively control quality of the resulting work product. Applicant thus respectfully requests that the rejection of dependent Claims 5, 27, 69, and 78-79 as unpatentable over the reference be withdrawn, and that such claims be allowed on their own merits, as well as on the merits of the claims from which they depend.

Rejection of Claims Under 35 USC § 102

Claims 23-26, 28, 29, 65-68, 70-74, and 76 stand rejected under 35 U.S.C. 102(b) as being anticipated by Currie. Applicant respectfully traverses the rejection.

However, in the interest of moving the case toward allowance, independent Claims 23 and 65 have been amended to recite the claimed lumber product as being a pre-marked lumber, meaning that the lumber has been marked with stud indicator markings before the lumber arrives at the construction/job site.

In order to further distinguish the claimed invention from the prior art, independent Claims 23 and 65 have also been amended to recite the stud locator markings reflecting application of the markings by at least one of a marking machine or a lumber-modifying process, not by a hand-held marker. This language finds support at page 14 line 35 to page 15 line 5, and elsewhere, in the application as originally filed.

Thus, independent Claims 23 and 65 have been amended to specifically require that the lumber product has been marked either by a marking machine or by a lumber-modifying process; for example an oxidizing process, and specifically excludes lumber product which has been marked by a hand-held marker.

No reference of record reflects marking which has been made by the recited marking machine or lumber-modifying process. Accordingly, independent Claims 23 and 65 are patentable on the basis of any one of the following:

- a. as pre-marked lumber as now recited in independent Claims 23 and 65, and
- b. as reflecting marking made by marking machine or lumber-modifying process.

Applicant respectfully requests withdrawal of the rejections of independent Claims 23 and 65, and all claims dependent therefrom, and allowance of all such claims.

New independent Claim 80, and dependent Claims 81-84 have been added. Since the indication of the 2/14/2006 Office Action was improper under the MPEP, new Claims 80-84 should be entered without any assertion of raising a new issue.

Further, independent Claim 80 recites the marking process set forth in Claims 1, 23, and 65, in product-by-process format, in order to even more clearly distinguish the claimed invention from the prior art of record.

Specifically, Claims 80-84 recite a pre-marked lumber product, the stud locator markings (12) having been associated directly with said pre-marked elongate piece of lumber by a process selected from the group consisting of

- (i) using a machine printing process to print ink directly on the elongate piece of lumber, thereby to develop the markings directly on the lumber product,
- (ii) mechanically cutting such markings into the elongate piece of lumber,
- (iii) burning such markings into the elongate piece of lumber, and
- (iv) chemically treating the elongate piece of lumber so as to produce the markings.

No prior art reference of record teaches or suggests any lumber product made by such processes. Accordingly, Claim 80, and all claims dependent therefrom, are allowable over the references of record.

Applicant respectfully requests that all bases of objection and rejection be withdrawn, and that all of Claims 1-11, 23-30, 65-84 be allowed. In light of the above, a prompt Notice of Allowance would be greatly, and sincerely, appreciated by Applicant.

A third Notice of Appeal is submitted herewith, along with a letter to the Examiner stating that the Notice of Appeal fee was previously paid, and Applicant never received a review of this case by the Board of Appeals and Interferences, whereby no fee is due for the Notice of Appeal.

No fee is believed to be due with any document being submitted herewith. Should any fee be properly due, or if any refund is due, kindly charge same, or credit any overpayment, to Deposit Account 23-2130.

Respectfully submitted,
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